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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

ELISCA, PIERRE E

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/750,772

Applicant(s)

MEYERS ET AL.

Examiner

Pierre E. Elisca

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-42 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office action is in response to applicant's response, filed on 12/17/2004.
2. Claims 1-42 are pending.

Allowable Subject Matter

3. Claim 8 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-7 and 9-42 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Ogasawara (U.S. Pat. No. 6,386,450) and Cerf et al. (U.S. Pat. No. 6,418,138) and Ogasawara (U.S. pat. No. 6,513,015) in view of Ollikainen et al (U.S. Pat. No. 6,377,981).

As per claims 1, 3-6, 9-12, 15-28, 30-34 and 36-42 Ogasawara discloses an electronic personal shopping system, communicating between a store computer and a mobile terminal, for organizing a consumer's movement through a retail facility in accordance with the consumer's current location (a method for public wireless network access), the method comprising the steps of:

detecting the presence of a local Area Network (LAN) by at least one mobile device at a LAN location, the detected LAN providing wireless network access to a global data network with at least one mobile device at a location (see., abstract, col 1, lines 12-17, col 3, lines 42-52, please note that col 5, lines 47-67, and col 6, lines 1-15 show a LAN that can be connected to the mobile terminal). It is to be noted that Ogasawara fails to explicitly disclose the process of requesting identification information from the at least one mobile device through a node of the LAN, sending the requested user identification information from the at least one mobile device to the access node of the LAN, the user identification information including personal and demographic information about a user of the at least one mobile device, sending the demographic information about the users of the at least one mobile device to an advertising server, providing access to the global communication data network through a gateway of the LAN to the at least one mobile device in response to receiving the demographic information about the user of the at least one mobile device by the advertising server from the access node of the LAN, accessing the global communication data network through a gateway of the LAN with the at least one mobile device, receiving commercial messages through the gateway from the advertising server, the commercial messages being selected based on the

demographic information of the users, sending the commercial messages to a display at the location for viewing by the users. Cerf discloses requesting identification information from the at least one mobile device through a node of the LAN (see., abstract, , col 3, lines 12-34, the gateway or proxy server is capable of identifying information,(see., abstract, col 2, lines 35-45, col 4, lines 51-67, col 3, lines 37-59, col 5, lines 45-56, col 4, lines 51-67, col 5, lines 45-56, col 3, lines 11-27, col 3, lines 11-27, and col 1, lines 12-65, col 3, lines 37-59).

It is to be noted that Cerf fails to explicitly disclose the step of receiving the demographic information about the user of at least one mobile device. However, Ogasawara discloses an electronic shopping that provides for customer recognition using wireless identification. A customer ID card is further useful in assisting each customer in making purchase transactions. The customer ID card is used in connection with a customer assistance which is able to develop and display various personalized assistance recommendations based on an analysis of demographic and mobile terminals (see., abstract wherein said customer's demographic profile, col 3, lines 50-67, col 4, lines 1-33, col 5, lines 17-37). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Ogasawara and Cerf by including the limitation detailed above as taught by Ogasawara "015 because this would provide the benefit of determining that a particular customer has made any purchases of items based upon the customer ID.

Ogasawara, Cerf and Ogasawara "015 fail to disclose the steps of receiving commercial messages from the advertising server, the commercial messages

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being selected based on the forwarded demographic information of each of the users provided with the access to the communication data network; and display the received commercial messages on at least one display at the LAN location for viewing by all persons at said LAN location. Ollikainen discloses a modular digital data communication cyberstation that is a modular computer and server that is external to the personal computers to which data is to be distributed. The cyberstation receives, optionally stores (commercial messages and advertising), and distributes the broadcast and interactive data to the personal computers. An optional pass-through television interface may be used to display (displaying commercial messages and advertising) the broadcast data on a television receiver (see., abstract, fig 1, col 1, lines 40-65, col 2, lines 39-67, col 3, lines 1-67, col 4, lines 1-67).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Ogasawara, Cerf, and Ogasawara "015 by including the limitation detailed above as taught by Ollikainen because this would provide the benefit of presenting or displaying messages and advertising to a particular customer has made any purchases of items based upon the customer ID.

As per claims 2, 7, 13, 14, 29 and 35 Cerf discloses the claimed method, wherein the advertising server is managed by an advertising service (see., col 3, lines 37-59, col 5, lines 45-56).

RESPONSE TO ARGUMENTS

5. Applicant's arguments filed on 12/17/2004 have been fully considered but they are not persuasive.

REMARKS

6. In response to Applicant's arguments, Applicant argues that the prior art of record fail to disclose:

a. " the combined teachings of the cited references , it is submitted, would not have led one of ordinary skill to achieve the invention". The Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. In *re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). See also *In re Eli Lilli & Co.*, 902 F.2d 943, 14 USPQ2d

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1741 (Fed. Cir. 1990) (discussion of reliance on legal precedent); *In re Nilssen*, 851 F.2d 1401, 7USPQ2d 1500 (Fed. Cir. 1988) (references do not have to explicitly suggest combining teachings); *Ex parte Clapp*, 227 USPQ 972 (Bd. Pat. App & Inter); and *Es parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993) (reliance on logic and sound scientific reasoning).

Also in reference to *Ex parte Levengood*, 28 USPQ2d, 1301, the court stated that "Obviousness is a legal conclusion, the determination of which is a question of patent law.

Motivation for combining the teachings of the various references need not to explicitly found in the reference themselves, *In re Keller*, 642 F.2d 413, 208USPQ 871 (CCPA 1981). Indeed, the Examiner may provide an explanation based on logic and sound scientific reasoning that will support a holding of obviousness. *In re Soli*, 317 F.2d 941 137 USPQ 797 (CCPA 1963)."

b. "detecting the presence of a local area network by one or more mobile devices". As indicated above, it is believed that Ogasawara discloses this assertion in the abstract, col 1, lines 12-17, col 3, lines 42-52. Please note that col 5, lines 47-67, and col 6, lines 1-15 show a LAN that can be connected to the mobile terminal).

c. "global communication data network or a local area network". However, the Examiner respectfully disagrees since Cerf discloses requesting identification information from the at least one mobile device through a node of the LAN (see., abstract, , col 3, lines 12-34, the gateway or proxy server is capable of identifying information,(see., abstract, col 2, lines 35-45, col 4, lines 51-67, col 3, lines 37-59, col 5, lines 45-56, col 4, lines 51-67,

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col 5, lines 45-56, col 3, lines 11-27, col 3, lines 11-27, and col 1, lines 12-65, col 3, lines 37-59).

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre E. Elisca whose telephone number is 703 305-3987. The examiner can normally be reached on 6:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703 305-9769. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Pierre Eddy Elisca

Primary Patent examiner

April 05, 2005